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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/361,652	07/27/99	ZUKER	C 2307E-088610

020350 HM12/0103
TOWNSEND AND TOWNSEND AND CREW LLP
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EXAMINER

BRANNOCK, M
ART UNIT PAPER NUMBER

1646 4
DATE MAILED: 01/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/361,652

Applicant(s)

C.S. Zuker et al.

Examiner

Micha I Brannock, Ph.D.

Group Art Unit

1646



☒ Responsive to communication(s) filed on Nov 15, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-63 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-63 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Sequence Compliance

1. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Applicant must comply with the sequence rules, 37 CFR 1.821 - 1.825, within the statutory period set forth for response in this Office Action. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-18, 34, 35, and 61-63, drawn to nucleic acids of SEQ ID NO: 4, 5, and 6 (encoding a polypeptide of SEQ ID NO: 1, 2, and 3), vectors, host cells and methods of making a polypeptide, classified in class 536, subclass 23.5.
 - II. Claims 19-32, drawn to polypeptides of SEQ ID NO: 1, 2, and 3, classified in class 530, subclass 350.
 - III. Claim 33, drawn to an antibody, classified in class 530, subclass 388.22.

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IV. Claims 36-60, drawn to a method for identifying compounds which modulate sensory signaling, classified in class 436, subclass 501.

3. The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products appear to constitute patentably distinct inventions for the following reasons: Groups I-III are directed to products that are distinct both physically and functionally, and are not required one for the other, and are therefore patentably distinct. Further, the protein of Group II can be prepared by processes which are materially different from recombinant DNA expression of Group I, such as by chemical synthesis, or by isolation and purification from natural sources. Additionally, the DNA of Group I can be used other than to make the protein of Group II, such in gene therapy or as a probe in nucleic acid hybridization assays. The protein of Group II can be used in materially different methods other than to make the antibody of Group III, such as in therapeutic or diagnostic methods (e.g., in screening). Finally, although the antibody of Group III can be used to obtain the DNA of Group II, it can also be used in materially different methods, such as in various diagnostic (e.g., in as a probe in immunoassays or immunochromatography), or therapeutic methods.

The nucleic acids of Group I and the method of Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another

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materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, although the nucleic acids could be used to express the protein used in the method of Group IV, the nucleic acids can be used in other materially and functionally different ways, such as in hybridization assays.

Similarly the polypeptides of Group II and the method of Group IV are related as product and process of use. The polypeptides of can be used in materially and functionally different ways other than that required of Group IV, such as to produce the antibodies of Group III to be used in diagnostic assays.

Furthermore, the antibody of Group III is patentably distinct from the method of Group IV because one is not required for the use of the other.

Therefore, a search and examination of all the groups in one patent application would result in an undue burden, since the searches for the groups are not co-extensive, the classification is different, and the subject matter is divergent.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Thursdays from 8:00 a.m. to 5:30 p.m. The examiner can also normally be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Elizabeth C. Kemmerer

ELIZABETH KEMMERER
PRIMARY EXAMINER

MB



December 20, 1999